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09/421,108	10/19/1999	HANS HSU	3783-4001	3647

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/421,108

Applicant(s)

HSU ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 195-214, 216-230 and 232-251 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 195-214, 216-230 and 232-251 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This communication is in response to amendment filed 10/26/04.

Response to Amendment

2. Claims 195-214, 216-230, and 232-251 including newly added claims 240- 251 are currently pending.

Response to Arguments

3. Applicant's arguments with respect to claims 195-214, 216-230 and 232-239 have been considered but are moot in view of the new grounds of rejection.

Statute Cited in Prior Action

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 195-211 and 240-249 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following exemplary analysis of independent claim 195 applies to all aforementioned claims.

Claim 195 recites limitation "the uncommitted balance of the selected gift's purchase price". However, the step "receiving ..commitments from the gift givers for monetary contribution.." is not linked to this limitation. In other words gift givers do not have access to the information of the uncommitted balance so that a decision regarding the giver-desired portion of the uncommitted balance may be accomplished.

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Examiner has interpreted that "the uncommitted balance of the selected gift's purchase price" is made available to the giver givers prior to the step of receiving of commitments.

Claims 196-211 also contain this deficiency.

Claims 212-230 and 232-239 recite limitation "the uncommitted balance" without any antecedent basis in the claim. The display of gift ideas provide only "total gift amount". It is unclear whether the giver givers provide commitments with or without having information regarding the uncommitted balance.

Claim Rejections - 35 USC § 103

5. Claims 195, 196, 198, 201, 204-212, 216-220, 226-228 and 234 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and further in view of article by Douglass, Alexander, G. "Experience vs. Logic in Fund Raising" Fund Raising Management, v23, n4, p44(3) June 1992 (Douglass) .

Claim 195: Ucopia discloses a method for enabling a plurality of gift givers to each make a respective commitment for monetary contribution of any giver-desired amount toward a gift for a gift recipient, the method comprising:

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Receiving at a centralized gift registry computer system gift ideas supplied by the gift recipient ("couples can choose items from an extensive list ...to build a personalized registry"..., para 5);

Storing the gift ideas in a memory which is part of , or accessible to, said gift registry computer system (this step is inherent in Ucopia, since the items chosen by the registered couples are to be presented to the potential gift givers via the gift registry);

Providing to the gift givers, based on the stored gift ideas and in response to requests supplied to said gift registry computer, an on-line of gift ideas (Ucopia: "guests enjoy the convenience of accessing all the selections in one place, and purchasing online...", para. 5);

Receiving at said gift registry computer system commitments from the gift givers for monetary contributions toward the purchase of a gift selected from the on-line display of gift ideas (Ucopia: higher-priced items may be designated for group purchases...refer to "Ucopia features" para 7, one of the features is that a gift of high price, which may be beyond "their individual budget" are selected for collective or group purchases);

Combining the commitments for monetary contributions and updating the display of the gift ideas to reflect the current commitments towards the selected gift (since the gift(s) selected for collective purchasing are designated as such, it is inherent that a potential contributor is informed of the commitment (monetary amount) already committed towards the gift or alternatively commitment amount still required towards the full amount of the item);

Automatically generating a purchase request for the selected gift if the total of the commitment is equal to or greater than the gift's purchase price(Ucopia instantly updates couple registries after purchases..., the automatically generating purchase request step is anticipated because the registered gift is designated for purchase via the registry);

Attempting to satisfy the purchase request (see discussion of above limitation "automatically generating purchase request...));

Ucopia, fails to disclose that the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price. It should be noted that broadly interpreted Utopia in no way restricts the monetary value of a share of a gift item, only the number of shares a giver may purchase (as

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noted by the applicant) is restricted to "one or more". This means a recipient may attribute a value of a penny (or a smallest denomination of currency) which would enable the givers to commit "any" desired monetary amount towards the gift since amount may be expressed in any giver desired amount even if the amounts expressed as shares of the gift item.

Douglass, in the same field of endeavor, discloses that each giver in a group of a plurality of givers, wherein each giver commits to make a monetary contribution for any giver-desired portion of the uncommitted balance of a pre-determined donation amount. (refer to setting a goal and size of the desired contribution). Douglass, like in any group giving situation discloses a required process of recording commitment of each giver (for reporting and book-keeping). Douglass, also, require that the price information communicated to and commitments received from each giver be expressed in terms of monetary amounts (dollars and cents).

It would have been obvious to modify Utopia gift registry method in accordance with Douglass method of group giving where the commitment of each giver that commits to make a monetary contribution is for any giver-desired portion of the uncommitted balance of the gift's purchase price. Because, doing so would allow the givers to contribute any desired monetary amount

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towards an expensive gift, thereby not restricting the monetary contribution to a multiple of share price designated. This would allow more gift givers to participate to commit monetary amounts towards purchase of expensive gifts. Another advantage of this modification of Utopia in accordance with Douglass would be that it would allow the recipient to specify the required amount of the gift in straight monetary units, i.e. Dollars and Cents (or nearest Dollars for convenience) unlike in Utopia which requires to the recipient to arbitrarily set a number of shares for a gift idea designated for group giving which restricts the givers to only a multiple of share units.

Claim 196: commitment of each giver commits to make a monetary contribution is directly specified by the giver as an amount of money (since each share represents an underlying predetermined fixed monetary amount, the giver may specify any amount of money appropriate to monetary value of a gift by specifying number of shares that represent his/her desired contribution, in other words, since the share price of Utopia is an alternative representation of money).

Claim 198: sending the purchase request to a supplier (inherent feature of an on-line purchase such as Utopia).

Claim 201: receiving credit card information supplied by the gift givers that make commitments (extremely conventional

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method of payment and therefore anticipated for gift purchase and/or commitment of gift amount).

Claims 204-206, 216-217, 224-225, 232-233 and 238-239:

features of receiving cash if the total of commitments is less than the gift's purchase price, one or more gift-ideas specified by the gift recipient is associated with a recipient is associated with a recipient determined price (or vendor) (well established business practices and therefore inherent to this reference).

Note that Claims 207 and 208 have been analyzed as per corresponding method claim 195. Since Ucopia method is implemented over the Internet both Computer-readable medium that store instructions and a programmed computer that is programmed to perform the method step are inherent to Ucopia.

All limitations of system claims 209 have been analyzed as in corresponding method claim 195.

Claim 210: communication network is the Internet (para 1,...the Internet's leading gift registry..).

Claim 211: limitation of the gift giver directly specifying the contribution as an amount of money is discussed in claim 195 as a combination of Utopia and Douglass.

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Claim 212 is analyzed similarly as per claim 195 with the following further explanation of the applied references:

Douglass teaches that the gift price (total gift amount) is specified in dollar amount and the members of the group donors commits (pays) a part of the total gift amount of the gift (amount paid by a giver towards the total amount of funds to be raised). Also note that the aforementioned commitment of each giver for part of the total gift amount is directly specified by the gift giver as an amount of currency (the amount reflects amount of currency paid by a buyer).

For motivation of combining the Utopia and Douglass please refer to analysis of claim 195.

Claims 216-217 are analyzed per claims 204 and 205 respectively.

Claims 218 and 219 have been analyzed as per corresponding method claim 212. Note that since Utopia method of gift giving is computerized (internet based) both storage medium (claim 218) and a computer system are inherent therein.

Claim 220: This claim requires that each gift idea received and stored has corresponding "specified total gift amount". The gift ideas and the gift amounts are then displayed to gift givers who commit a part of the total gift amount for a selected gift idea. Commitments from gift givers for the gift ideas are

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combined and purchase request is (automatically) generated if the total amount of the commitments for a gift idea is reached or exceeds the specified total gift amount for that gift idea.

The analysis of claim 195 already reflected "specified total gift amount" as "price" of the gift. All other steps were predicated on the gift giver knowing the price (any giver desired monetary amount) as discussed as in combination of Utopia and Douglass.

Claims 226 and 227 have been analyzed as per corresponding method claim 220. Note that since Utopia method of gift giving is computerized (internet based), therefore, both storage medium (claim 218) and a computer system are inherent therein.

Claims 228 and 234 are analyzed as per corresponding method claims 212 and 220 respectively.

1. Claim 197, 213, 221, 229 and 235 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utopia and Douglass as applied to claim 195 and further in view of weddingchannel.com.

(Exemplary analysis of claim 197 applies to other aforementioned claims)

Claim 197: generating one or more web pages based on gift ideas supplied by the gift recipient; and supplying the generated web pages to the gift givers in response to giver-supplied requests (refer to link "view item" next to the item

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listed, the giver is supplied with the web pages pertaining to the gift of interest);

Ucopia as applied to claim 195 fail to clearly recite the features of aforementioned claims. However, as discussed above, weddingchannel.com discloses generating web pages, supplying web pages to gift givers. It would have obvious to one of ordinary skill in the art at time of the claimed invention to implement these steps in Ucopia/Douglass combination as analyzed per claim 195.

Motivation for adding this feature is to provide the giver all necessary information and graphic display about the gift item so as to help him or her view the gift item and make decision towards gift purchase.

2. Claims 199 and 200 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and Douglass as applied to claim 195 and further in view of Ojha et al (US Pat. 6,598,026) (Ojha)

Claim 199: Utopia as applied to claim 195 fail to teach features of sending an offer to purchase the selected gift to a plurality of vendors and subsequently receiving an acceptance of the offer from one of the vendors and requesting the accepting vendor to send the selected gift to the recipient. However, Ojha, in the same field of endeavor discloses a method for brokering transactions. Ojha teaches sending offers to purchase the selected (gift) item (a plurality of products, abstract) to a plurality of vendors (sellers), an acceptance of the offer

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from one of the vendors and accepting offer as per claim 199. It would have been obvious to one of ordinary skill in the art at the time of invention to implement in Utopia/Douglass combination as analyzed per claim 195, the feature of sending purchase offers to a plurality of vendors and receiving an acceptance of offer from one of the offers from a vendor as per Ojha because this would provide the most competitive price of the selected gift item for the buyer.

All other limitations of claim 199 are analyzed as per claim 195.

Regarding claim 200, the cited references of Utopia and Douglass as discussed in analysis of claim 195 fail to teach adding the purchase request and aggregating purchase request while they teach sending the offer to a plurality of vendors to fulfill the offer of the gift item. Ojha, in the same field of endeavor, discloses sending request for a purchase of a plurality of products and subsequent consummation of the purchase request (bid) (see abstract and Background of the Invention).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement the steps of adding purchase request and aggregating purchase request and sending

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purchase offers to a plurality of vendors and receiving an acceptance of offer from one of the offers from a vendor because this would provide the most competitive price of the selected gift item for the buyer. Aggregating purchase request for identical products would allow the purchaser to receive more favorable price due to volume discount.

All other limitations of claim 200 are analyzed as per claims 195 and 199.

3. Claims 202, 214, 222, 230 and 236 are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and Douglass as applied to claim 195 and further in view of Kopetman (Starr Rides to Freedom Bowl rescue Last-Day Scramble Secures Necessary Loans, Donations, The Los Angeles Times June 28, 1986 pg. 5 (Kopetman)).

[Note: The following analysis of claim 202 applies to all other aforementioned claims]

UCOPIA as applied to claim 195 (claim 212 for claim 214) fail to teach however in the same field of endeavor, Kopetman teaches receiving commitments from the gift givers that include commitments which are contingent upon other gift givers making commitments such that the total of all commitments is equal to or greater than the price of the selected gift (refer to

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abstract, and full text, \$527,000 corresponds to total price of the gift, \$125,000 is contingent amount..).

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the feature of a giver making a commitment which is contingent as per Kopetman in the above referenced combination of UCOPIA and Douglass because the gift giver would be assured of the purchase of the selected gift. Furthermore, such contingent commitment would also entice other givers to commit their contribution towards the selected gift.

4. Claims 203, 215, 223, 231 and 237: are rejected under 35 U.S.C. 103(a) as being unpatentable over UCOPIA and Douglass as applied to claim 195 and further in view of Linstedt (Shoppers Sweep into Area Stores), Buffalo News, November 29, 1997. (Linstedt).

Claims 203 (exemplary): UCOPIA fail to disclose, however, in the same field of endeavor, Linstedt discloses, that when shopping for gifts the receivers desire a substitute gift item in lieu of a specific gift item. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the recipient specify a substitute option added to Ucopia/Douglass combination as analyzed per claim 195 because it

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would ensure that a gift item similar to the one substituted for is available for the givers to select from.

Claims 215, 223, 231 and 237 are similarly analyzed.

Claims 240-251 recite limitations, which have been analyzed in claims 195 and 203 combined. It is noted that the features recited in claims 241-244 are different circumstances under which a merchant would substitute a selected gift item in order to improve customer satisfaction or customer loyalty. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide these features of substituting the gift as per desires of the gift recipient as a sound marketing decision for the reasons indicated above.

Claims 245-249 are rejected based on similar analysis.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

3/7/05